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10/796,030	03/10/2004	Shushi Takiyama	1046.1315	2151

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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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11/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,030

Applicant(s)

TAKIYAMA, SHUSHI

Examiner

Khanh H. Le

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/10/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/10/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/10/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the original application. Claims 1-18 are pending. Claims 1, 4, 6, 9, 11, 14 and 16 are independent.

2. The Examiner thanks Mr. Gene Garner for calling back yesterday about a restriction requirement. Upon further consideration, the Examiner determines a requirement is not needed at this time because the prior art applied (Logan, see below) applies to both species.

However, the Examiner reserves the right to make a restriction requirement after this first action on the merits, before final action, if following amendments, there will be a serious burden if restriction is not required. See MPEP 811 citing 37 CFR 1.142(a).

As the Examiner indicated, present claims 5, 10, 15 and 18 are mutually exclusive of claims 2, 7, 12, and 17. (Claims 5, 10, 15 and 18 generate instructions at the advertisement information management device (herein "AIMD") then transfers the instruction to the information recording device (herein "IRD") while claims 2, 7, 12, and 17 claim that the instructions are generated at the IRD. See e.g. specifications at paragraphs [0035] and [0076] which describe the two mutually exclusive species.

Specification

3. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required because, for example, paragraphs [0006]-[0010] and [0033] are incomprehensible. Many others are as well. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Independent claims 11 and 14 are rejected as directed to software per se ("an information recording program") which is non-statutory subject matter. Claims 12-13, and 15 are rejected based on their dependency.**

(Note: "for making a computer for recording received information function as" is only a statement of purpose, thus does not save the claims from being non-statutory. "[I] information recording program" is functional descriptive material. Functional descriptive material **if recorded on some computer-readable medium**, can become structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. See MPEP 2106.01.).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan et al. US 6199076.**

Independent claims 1, 6, 11, 16 and 4, 9, 14 and dependent claims 3, 8, 13:

Logan discloses radio or television programming and advertising broadcasted and compressed for local storage (at storage 107 of Figure 1) (col. 6 lines 62-67, col. 5 lines 35-39) based on explicit or implicit user preferences. The resulting programming may then be selected for inclusion in the user's program library and selected for playback under user control. The cost of programming could be financially supported in whole or in part by subscription fees, or by advertising, and users could elect the extent to which they were willing to view advertising in exchange for reduced subscription fees. Ads are inserted at user device (player) automatically based on user predetermined cost control instructions or under specific user control (col. 11 lines 16-37; Figure 3 step 235 and associated text). Specific user experience of the ads is recorded so to provide user discounts as well as billing advertisers (abstract, .

Thus Logan discloses:

An advertisement information management system and method comprising:

a) an information recording device (IRD) (user player, Figure 1 item 103) including:

a1) record executing unit (and/or associated computer program) (Figure 1 item 105 : CPU and program, col. 11 lines 16-37,) for **inserting advertisement information into information (i.e. programming)** (and thus recording the information on recording unit) recording the (ads) information in accordance with instruction information (col. 11 lines 16-37; col. 12 lines 28-34. Figure 3 step 235 and associated text)

(Notes on interpretation:

Note #1: in Logan, user player instructions to insert into a server-suggested compilation of segments, e.g. at col. 11 lines 16-37, col. 12 lines 28-34, are interpreted as instructions *"indicating whether or not the advertisement information is inserted into the information"* . This is because each ad segment is specifically identified (Fig 5 and associated text) and has a beginning and end (col. 46 lines 13-27). Thus implicitly Logan's system can detect whether an ad had been inserted and if not, it would be inserted as instructed).

Note #2: This interpretation is consistent with the instant specification because although the phrase *"a piece of instruction information indicating whether the advertisement information is inserted into the information or not"* (in the ad insertion step) is repeated many times in the specification, it is not explained any further, nor are any details given on how that is achieved. Thus the phrase is reasonably interpreted as a mere instruction to insert the ad into the programming content. Logan discloses that. In other words, on this issue, Logan discloses at least as much as the instant application.

Note #3: the phrase *"a piece of instruction information indicating whether the advertisement information is inserted into the information or not"* is also reasonably interpreted as a mere instruction to insert because *"indicating whether the advertisement information is inserted into the information or not"* is just a label for the instruction, which label is non-functional descriptive material and does not affect the step of inserting (nor the device or system performing that step). Therefore the label is given little if any patentable weight. See MPEP 2106.

Also see the following USPTO Board of Appeals and Interferences Informative Decisions for similar analyses:

Ex parte James Prescott Curry,
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd050509.pdf>

Ex Parte Herman Mathias,
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd051851.pdf>, (affirming a 35 USC section 102 rejection) (also affirmed at the CAFC (August 17, 2006)).

and

a2) notifying unit (Figure 1 item 109, usage log and associated applications) **notifying** an advertisement information management device (IRMD) (for managing a user) (server 101 which contains user usage and data log 143 is interpreted as such a device, see Figure 1 and associated text) that **the advertisement information has been inserted** into the information and thus recorded on said recording unit (see e.g. col. 12 lines 58-67: ads display to user is monitored and reported to server 101.),

and

b) an advertisement information management device (AIMD) (server 101 which contains user usage and data log 143) including:

b1) receiving unit receiving the notification (Fig 1 item 143);

and

b2) advertisement information management unit updating data about the advertisement information on the basis of a content of the notification (Fig 1 item 143; updating data for billing, see abstract).

Claims 2, 7, 12, 17:

Logan discloses the system, method or computer program of claims 1, 6, 11 or 16 above and further discloses:

wherein said IRD (user player) further includes instruction information generating unit or program generating the instruction information (col. 11 lines 16-37; Figure 3 step 235 and associated text).

Claims 5, 10, 15 and 18:

Logan discloses the system, method or computer program of claims 4, 11, 14 or 16 above and further discloses:

wherein said AIMD (server 101) further includes instruction information generating unit (e.g. Figure 1 item 151: download processing unit) generating the instruction information (col. 8 lines 39-44);

(**Note:** Logan's server side instructions to insert particular ads into a compilation of programs and ads (col. 9 lines 25-29) to be sent to user and which would execute according to the server-generated sequence unless the user intervenes by editing, reads on "generating instruction information", (col. 8 lines 45-63). These instructions to insert according to a particular sequence (see Figure 5 and associated text) are also interpreted as instructions "*indicating whether or not the advertisement information is inserted into the information*" so to effect a particular sequence of insertions. This is inherent because each ad segment is specifically identified (see Figure 5 and associated text) and sequenced with a beginning and end (col. 46 lines 13-27; Fig 5). **Note also that interpretation notes #2 and #3 discussed at page 4 above also apply here).**

and

an instruction information transmitting unit (communications modules items 125 to storage 107 of Figure 1) transmitting the instruction information (e.g. sequence of replaying segments) to said information recording device used by the user (see Figure 1 and associated text).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Logan 2002/0120925 incorporating Logan US 6199076 and others discloses:

radio or television programming broadcasted and compressed for local storage, a "record selection" file of metadata used to selectively record programming of probable interest to the user at the user location, and the resulting programming may then be selected for inclusion in the user's program library and selected for playback under user control. The cost of programming could be financially supported in whole or in part by subscription fees, or by advertising, and users could elect the extent to which they were willing to view advertising in exchange for reduced subscription fees ([0242]; [0235]; [0236]; [0242]). Advertising segments, like programming content, may be inserted into the programming at playback time and selected based on user preferences and demographics, helping to insure that the advertising presented is relevant to the consumer and hence of more value to the advertiser and the consumer ([0242]).

Insertion of ads into programming at user location are disclosed in more detail as [0252], [0253]. Also at [0080], [0117], [0235]-[0237].

Usage logs for billing and or crediting for ads viewing ([0024]) (including monitoring if ads are fast forwarding [0156]) or for user profiling [0081] are disclosed.

Logan, US 5721827, US 6931451 B1 discloses systems and methods for modifying broadcast programming with personalized information.

Khoo, US 2002/0165770 discloses method for providing content with an option.

Freeman US 7079176 discloses interaction with live programming events.

Matz, US 7212979 B1 discloses system and method for identifying desirable subscribers for broadcasting.

Ebisawa US 6539544 B2 discloses Game machine system, broadcasting system, data distribution system, and method, program executing apparatus and method.

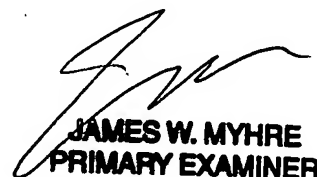
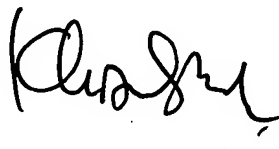
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 14, 2007

KHL



JAMES W. MYHRE
PRIMARY EXAMINER